

REMARKS

Claims 51, 56-69, 71-76, and 78 are rejected under 35 U.S.C. §103 as unpatentable over Hohberger in view of Grose. Claims 52-53, 70, and 77 are rejected under 35 U.S.C. §103 as unpatentable over Hohberger modified by Grose further in view of Funk. Claims 54-55 are rejected under 35 U.S.C. §103 as unpatentable over Hohberger modified by Grose further in view of Veitch.

Claim 51 distinguishes over Hohberger combined with Grose for the following reasons. Claim 51 recites a unique identifier stored in unchangeable fashion in an electronic storage region of the transponder. The Examiner has indicated that Hohberger does not have this feature and therefore cites the secondary reference Grose. However, Grose, although having an RFID which may be a read-only memory with a preset identification number (paragraph 0040), is not an obvious combination with Hohberger since there is no connective teaching between the references and Hohberger in fact teaches away from such a combination. Hohberger teaches that the card member data base 314 is freely programmable and the card member unique identifier information would be freely programmable. Thus one skilled in the art would not combine Grose with Hohberger.

Claim 51 next distinguishes by reciting providing a file with information to be printed on the printed document, said file not yet having said unique identifier stored therein. This is brought out in Applicants' Substitute Specification at page 9, lines 6-9 stating that the recording medium is printed and then immediately following this print event, the transponder is read and the read information is

linked with the printed data in a data bank (see data file 22, for example, in Fig. 2). Thus the read information from the transponder is not initially in the data bank with the printed data but is linked to the printed data in the data bank later in the transponder reading event after the print event. Hohberger teaches directly away from this, since in Hohberger all of the card member information, both the information to be printed and the information to be stored in the transponder, is stored together and in common in the data base 314. In Hohberger, as discussed hereafter, when reading is done, there is no linking being performed at that time, since the information for printing and the information for writing on the transponder was already stored together previously in the data base 314.

Claim 51 next distinguishes by reciting reading the unique identifier from the transponder after the printing and linking the unique identifier read from the transponder in the file with the information printed on the recording medium. For this feature, the Examiner cites paragraph 106 of Hohberger and particularly the fifth line from the bottom of that paragraph where it states that "...the information stored in the memory of the RFID transponder labeled 244 *is read* (emphasis added) wirelessly and used to automatically set up the platinum member's global e-mail account". The Examiner further cites paragraph 121 stating that the RFID transponders contain target-specific data used in after processing the card when returned, and paragraph 122 stating that on-demand printing on the transponders is tied to the target in the stored information. From these disclosures, the Examiner concludes that there is a "linking of the unique identifier read from the

transponder” with the information printed on the recording medium. However, this is not correct. What Hohberger is describing at the above-identified paragraphs as most clearly indicated at paragraph 106, five lines from the bottom, is that the information stored in the memory of the RFID transponder which is read is “...used to automatically set up the platinum members global e-mail account”. This information is thus not used after the reading of the unique identifier to link the unique identifier just read from the transponder with the information printed on the recording medium previously.

In Hohberger, a master file contains information to be printed and also information to be written on the transponder. This linking of the information to be printed and information to be written on the transponder is already previously accomplished in the memory before printing. There is thus no linking of the unique identifier which is occurring after the reading of the transponder. In a method claim, weight must be given to the order of the steps in the method as recited. In Applicants claim 51, the linking is occurring *after* the reading. In Hohberger, the information written to the transponder was previously linked to the printed information, but that linking is not being established *after* the reading.

Grose does not satisfy the above deficiencies of Hohberger. Grose shows an RFID 12 which is merely read and that read information is then written into a card disk database. There is no reading of the unique identifier which is then followed by linking of the unique identifier just read with previously printed information.

Dependent claims 52-64 distinguish at least for the reasons noted with respect to claim 51 and also by reciting additional features not suggested.

Independent claim 65 distinguishes over Hohberger in view of Grose at least for the reasons noted with respect to claim 51. Dependent claims 66 and 67 distinguish at least for the reasons noted with respect to claim 65 and also by reciting additional features not suggested.

Claim 68 distinguishes at least by reciting the unique identifier being stored in unchangeable fashion in an electronic storage region of the transponder by reciting the file not having the unique identifier stored therein, and also by reciting reading the unique identifier and linking the unchangeably unique identifier with the information printed on the recording medium. This language is similar to claim 51 and thus distinguishes at least for the reasons noted with respect to claim 51.

Independent claim 69 distinguishes over Hohberger combined with Grose at least by reciting the unique identifier stored in unchangeable fashion. How this feature distinguishes was previously pointed out with respect to claim 51.

Independent claim 69 further distinguishes by reciting a file having information for printing on the printed document, the file not having said unique identifier stored therein. As pointed out above for claim 51, in Hohberger all the information is stored in the file from the beginning.

Claim 69 further distinguishes by reciting reading the unchangeable unique identifier from the transponder, and then printing the information from the file onto the recording medium to create the printed document and also linking

the unique identifier in the file to the information printed on the recording medium (the printing may occur before the linking or the linking may occur before the printing).

In Hohberger, at paragraphs 103 and 106, the information is first printed on the cards, the transponder is then programmed with information related to the printed information, and then the transponder is read and the read information is used to set up the member's global e-mail account. There is no reading of an identifier from the transponder on the member's card and then printing the information onto the member's card and linking. In Hohberger, there is only a printing followed by a writing of information onto the transponder. There is no printing following the reading of the unchangeable unique identifier. There is also no linking after the reading since in Hohberger the information was already previously stored together in the card member memory file and thus a linking step is not performed after the reading.

It is not obvious to combine Grose to satisfy the deficiencies of Hohberger as pointed out above with respect to claim 51, since Hohberger teaches away and there is no connective teaching – in Hohberger the memory is freely programmable and therefore one would not substitute the read-only memory of Grose.

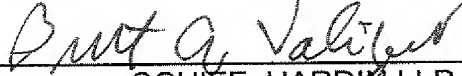
Dependent claims 70-78 distinguish at least for the reasons noted with respect to claim 69 and also by reciting additional features not suggested in combination.

In the attached Second Supplemental Information Disclosure Statement, two new references are brought to the Examiner's attention. Reference AQ3 ('045) is somewhat similar to the teachings of Hohberger. See for example Figure 6 where the digital data and information contained together in the memory 103 is used for creating the digital document at 100 by printing thereon. Also information from memory 103 may be sent for storage as digital information at 108 on the attached storage medium on the document. This is similar to Hohberger's common storage of information in his card member file for printing and for storage on the RFID. This reference is thus no more relevant than the Hohberger reference and the claims distinguish in the manner described above for Hohberger.

Similarly for the additional reference AV (Finkenzeller), that reference is no more relevant than the Grose reference cited by the Examiner. Like Grose, Finkenzeller describes in the English language translation attached to the relevant pages of Finkenzeller a read-only transponder where an identification unique to the transponder is provided. Since this reference is no more relevant than the Grose reference, the same arguments apply as to why this reference as a secondary reference combined with any other primary reference such as the '045 or Hohberger, would not be an obvious combination. The '045 and the Hohberger references both teach a freely programmable memory for storing the information to be written on the memory attached to the document or for printing information on the document.

Allowance of the case is respectfully requested.

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